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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/734,852	12/11/2000	Hyun-Jeong Kim	678-578 (P9616)	4736

28249 7590 09/07/2004

DILWORTH & BARRESE, LLP  
333 EARLE OVINGTON BLVD.  
UNIONDALE, NY 11553

EXAMINER

LY, NGHI H

ART UNIT	PAPER NUMBER
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2686

DATE MAILED: 09/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/734,852	<b>Applicant(s)</b> KIM, HYUN-JEONG	
	<b>Examiner</b> Nghi H. Ly	<b>Art Unit</b> 2686	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 June 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-5, 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over John (US 6,216,106) in view of Choksi et al (US 6,477,243).

Regarding claims 1 and 16, John teaches the applicant's admitted prior art teaches a method of notifying a calling mobile station that a called mobile station has confirmed a message by the called mobile station (see Abstract, see column 4, lines 41-49 and see column 7, lines 39-44) after receiving the message from a mobile switching center (MSC) (see fig.1, box GMSC1) and informing the called mobile station of receipt of the message (see Abstract, see column 4, lines 41-49 and see column 7, lines 39-44) in a wireless communication system (see fig.1, wireless communication system 101), comprising the steps of: determining, when a voice call is not normally established (see column 3, lines 8-9, "If calling party tries to call the mobile subscriber when not available"), whether the called mobile station has confirmed the received message after the called mobile station is informed of receipt of the message (see Abstract, see column 4, lines 41-49 and see column 7, lines 39-44), and transmitting a confirmation message (see Abstract, see column 4, lines 41-49 and see column 7, lines 39-44),

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notifying that the message has been confirmed (see Abstract, see column 6, lines 30-40), if it is determined that the called mobile station has confirmed the received message (see Abstract, see column 5, lines 33-36).

John does not specifically disclose transmitting a confirmation message including a telephone number of a caller.

Choksi teaches transmitting a confirmation message including a telephone number of a caller (see column 9, lines 43-55).

Therefore, it would have been obvious to one of ordinary skills in the art at the time of the invention was made to provide the above teaching of Choksi into the system John so that a notification can be received by a particular user.

Regarding claim 2, John further teaches the message is a voice message (see Abstract).

Regarding claim 3, the combination of John and Choksi further teaches the message is a text message (see Choksi, Abstract).

Regarding claim 4, John further teaches the confirmation message is a data burst message (see column 5, lines 10-35, "play", "delete", "played" and "unplayed").

Regarding claim 5, John further teaches the confirmation message is a short message John further teaches the confirmation message is a short message (see column 5, lines 10-35, "play", "delete", "played" and "unplayed").

Regarding claim 17, John further teaches the step of determining, if the received message is a voice message (see column 6, lines 30-41 and see column 7, lines 39-45),

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whether the called mobile station is connected to a voice mail center in order to confirm the received voice message (see Abstract).

3. Claims 6-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over John (US 6,216,106) in view of Choksi et al (US 6,477,243) and further in view of DeGiorgio et al (US 3,866,206).

Regarding claims 6 and 11, John teaches a method of notifying a caller of message confirmation for a message transmitted (see Abstract, see column 4, lines 41-49 and see column 7, lines 39-44) when a voice call is not normally established (see column 3, lines 8-9, "If calling party tries to call the mobile subscriber when not available") upon request of a voice call in a wireless communication system (see fig.1, wireless communication system 101), comprising the steps of, transmitting the message to a called mobile station by a calling mobile station (see Abstract, see column 4, lines 41-49 and see column 7, lines 39-44), displaying information indicating receipt of the message and transmitting a confirmation message (see Abstract, see column 4, lines 41-49 and see column 7, lines 39-44), notifying the caller that a called party has confirmed the message by the called mobile station (see Abstract, see column 6, lines 30-40), and displaying information indicating receipt of the confirmation message by the calling mobile station (see column 7, lines 41-45).

John does not specifically disclose transmitting a confirmation message including a telephone number of a caller.

Choksi teaches transmitting a confirmation message including a telephone number of a caller (see column 9, lines 43-55).

Therefore, it would have been obvious to one of ordinary skills in the art at the time of the invention was made to provide the above teaching of Choksi into the system John so that a notification can be received by a particular user.

The combination of John and Choksi does not specifically disclose sounding an alarm upon receipt of the confirmation message.

DeGiorgio teaches sounding an alarm upon receipt of the confirmation message (see column 9, lines 64-68 and see fig.5, beeper 156).

Therefore, it would have been obvious to one of ordinary skills in the art at the time of the invention was made to provide the above teaching of DeGiorgio into the system John and Choksi so that the sender can response to the alarm faster.

Regarding claims 7 and 12, John further teaches the message is a voice message (see Abstract).

Regarding claims 8 and 13, the combination of John, Choksi and DeGiorgio further teaches the message is a text message (see Choksi, Abstract).

Regarding claims 9 and 14, John further teaches the confirmation message is a data burst message (see column 5, lines 10-35, "play", "delete", "played" and "unplayed").

Regarding claims 10 and 15, John further teaches the confirmation message is a short message (see column 5, lines 10-35, "play", "delete", "played" and "unplayed").

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**Conclusion**

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

**Heyen** (EP 0371605 A2) teaches electronic mail systems.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nghi H. Ly whose telephone number is (703) 605-5164. The examiner can normally be reached on 8:30 am-5:30 pm Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold can be reached on (703) 305-4379. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nghi H. Ly

*LLG*  
08/26/04

*Lester G. Kincaid*  
9/2/04  
LESTER G. KINCAID  
PRIMARY EXAMINER